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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,698	02/02/2000	ANDREW D. Simchik	XXT-036CP	6586

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EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 March 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23, 25 and 26_ is/are pending in the application.

    4a) Of the above claim(s) _25 and 26_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _22 March 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 3/22/04, and has been entered and made of

record. Currently, **claims 1-23, 25 and 26** are pending.

Response to Arguments

2.   Applicant's arguments, see pages 7 and 8, filed 3/22/04, with respect to the rejection(s)of

claims 1, 8, 13, 20, and 23 under 35 U.S.C.102(e) have been fully considered and are

persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration,

a new ground(s) of rejection is made in view of Robertson et al. (U.S. Patent Number 6,507,410),

which was cited in the Office action dated 11/18/03 under Pertinent Prior Art.

Drawings

3.   The drawings were received on 3/22/04. These drawings are acceptable by the examiner.

Election/Restrictions

4.   Newly submitted **claims 25 and 26** are directed to an invention that is independent or

distinct from the invention originally claimed for the following reasons:

Newly submitted independent claim 25 is a subcombination of the combination originally

claimed in claims 1-23.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination of originally filed claims 1-23, as claimed, does not require the particulars of the subcombination of newly filed claim 25, as claimed, because the printing system of claims 1-23 are drawn to translating web pages retrieved from a network, as well as inserting links into a document so as to retrieve a web page in response to the link.

The newly submitted subcombination has separate utility such as a file directory management method, as claim 25 is drawn to an invention that obtains a list of URLs stored in a client machine, browses and retrieves a selected web page associated with a URL from the list of URLS, stores a translated web page into a temporary directory, further translates the stored web page into an image file, which is then stored in the temporary directory, imports the image file into a document, and then deletes the temporary directory by the client machine.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25 and 26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 1-23**, are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson *et al.*

(U.S. Patent Number 6,507,410, cited in the Office action dated 11/18/03 under Pertinent Prior

Art).

Regarding *claim 1*, Robertson discloses in a printing system (see abstract), a method for

converting an existing page from a network into an image file suitable for assembly into a

document generated by a document creation algorithm (see Fig. 2, column 4, lines 34 through

57, and column 10, lines 7 through 53), the method comprising the steps of importing the

existing page from the network into the printing system (column 4, lines 34 through 57, and

column 10, lines 7 through 53), translating the existing page from the network into a page

description language (PDL) file representative of the page (column 10, lines 54 through column

11, line 55, and column 18, line 62 through column 19, line 3), and translating the PDL file into

an image file representative of the page suitable for assembly into the document (column 18, line

62 through column 19, line 37).

Regarding *claim 2*, Robertson discloses the method discussed above in claim 1, and

further teaches of the steps of launching a web browser, and retrieving the web page from the

network (column 8, line 53 through column 9, line 40).

Regarding *claim 3*, Robertson discloses the method discussed above in claim 1, and further teaches of the step of importing the image file into the document (column 4, lines 34 through 57, and column 10, lines 7 through 53).

Regarding *claim 4*, Robertson discloses the method discussed above in claim 1, and further teaches of the step of integrating the image file into the document (column 10, lines 54 through column 11, line 55, and column 18, line 62 through column 19, line 3).

Regarding *claim 5*, Robertson discloses the method discussed above in claim 1, and further teaches of the steps of converting the image file into a page, and importing the page into the document generated by the document creation algorithm (column 10, lines 54 through column 11, line 55, and column 18, line 62 through column 19, line 3).

Regarding *claim 6*, Robertson discloses the method discussed above in claim 1, and further teaches of the step of printing the image file with a printing module (see abstract, and column 6, line 26 through column 7, line 10).

Regarding *claim 7*, Robertson discloses the method discussed above in claim 1, and teaches that the page is a web page (column 4, lines 34 through 57, and column 10, lines 7 through 53), further comprising the steps of inserting a uniform resource locator (URL) into the document created by the document creation algorithm, the URL corresponding to the web page (column 4, lines 34 through 57, column 10, lines 7 through 53, and column 20, line 49 through column 21, line 61), and dynamically inserting the image file corresponding to the web page into the document (column 20, line 49 through column 21, line 61).

Regarding *claim 8*, Robertson discloses a method suitable for use with a printing system (see abstract, column 7, lines 19 through column 8, line 15) for dynamically linking content

present in a page in a network with a document (column 9, lines 6 through 40), wherein the page

is updated automatically without further user interaction, the method comprising the steps of

inserting a link into the document (column 12, lines 24 through 55), the link corresponding to a

page present in the network (column 5, line 55 through column 6, line 19), launching a browser

in response to the link (column 15, line 51 through column 16, line 9), retrieving the page from

the network (column 4, lines 34 through 57, and column 10, lines 7 through 53), and converting

the page into an image file suitable for insertion into the document (column 10, lines 54 through

column 11, line 55, and column 18, line 62 through column 19, line 37).

Regarding *claim 9*, Robertson discloses the method discussed above in claim 8, and

further teaches that the step of inserting a link comprises the step of inserting a uniform resource

locator (URL) into the document (column 4, lines 34 through 57, column 10, lines 7 through 53,

and column 20, line 49 through column 21, line 61), and wherein the step of launching comprises

the step of launching a web browser, wherein the URL corresponds to a web page in the network

(column 20, line 49 through column 21, line 61).

Regarding *claim 10*, Robertson discloses the method discussed above in claim 8, and

further teaches that the step of converting comprises the step directly inserting the image file into

the document (column 4, lines 34 through 57, and column 10, lines 7 through 53).

Regarding *claim 11*, Robertson discloses the method discussed above in claim 8, and

further teaches that the page includes a web page and the browser includes a web browser

(column 4, lines 34 through 57, and column 10, lines 7 through 53), further comprising the step

of automatically, dynamically inserting the link into the document to dynamically retrieve

content associated with the web page for subsequent incorporation into the document (column 15, line 51 through column 16, line 9).

Regarding *claim 12*, Robertson discloses the method discussed above in claim 8, and further teaches of the step of repeating the steps of inserting, launching, retrieving, and converting as a function of the number of links inserted into the document (column 18, line 47 through column 19, line 10).

Regarding *claim 13*, Robertson discloses a printing system (see abstract, column 7, lines 19 through column 8, line 15) for converting an existing page from a network into image data suitable for subsequent assembly into a document generated by a document creation algorithm (see Fig. 2, column 4, lines 34 through 57, and column 10, lines 7 through 53), the system comprising a browser for accessing the network and for retrieving and importing the existing page therefrom (column 4, lines 34 through 57, and column 10, lines 7 through 53), and a production facility for translating the page into an image file representative of the page and suitable for assembly into the document generated by the document creation algorithm (column 10, lines 54 through column 11, line 55, and column 18, line 62 through column 19, line 37).

Regarding *claim 14*, Robertson discloses the system discussed above in claim 13, and further teaches that the production facility comprises a first translator for translating the page into a page description language (PDL) file representative of the page (column 18, line 57 through column 19, line 18), and a second translator for translating the PDL file into an image file representative of the page (column 19, lines 19 through 37).

Regarding *claim 15*, Robertson discloses the system discussed above in claim 13, and further teaches that the page includes a web page (column 4, lines 34 through 57, and column 10,

lines 7 through 53), and that the production facility comprises a link facility for inserting a

uniform resource locator (URL) into a document created by the document creation algorithm

(column 4, lines 34 through 57, column 10, lines 7 through 53, and column 20, line 49 through

column 21, line 61), the URL corresponding to the web page (column 20, line 49 through

column 21, line 61).

Regarding *claim 16*, Robertson discloses the system discussed above in claim 13, and

further teaches of means for importing the image file into the document (column 4, lines 34

through 57, and column 10, lines 7 through 53).

Regarding *claim 17*, Robertson discloses the system discussed above in claim 13, and

further teaches of a printing module for printing the document (see abstract, and column 6, line

26 through column 7, line 10).

Regarding *claim 18*, Robertson discloses the system discussed above in claim 13, and

further teaches that the page includes a web page (column 4, lines 34 through 57, and column 10,

lines 7 through 53), further comprising a link facility for inserting a uniform resource locator

(URL) into a document created by the document creation algorithm (column 4, lines 34 through

57, column 10, lines 7 through 53, and column 20, line 49 through column 21, line 61), the URL

corresponding to the web page (column 20, line 49 through column 21, line 61).

Regarding *claim 19*, Robertson discloses the system discussed above in claim 17, and

further teaches of means for dynamically inserting the image file into the document (column 10,

lines 54 through column 11, line 55, and column 18, line 62 through column 19, line 3).

Regarding *claim 20*, Robertson discloses a printing system (see abstract, column 7, lines

19 through column 8, line 15) for dynamically linking content present in a page in a network

with a document generated by a document creation algorithm (see Fig. 2, column 4, lines 34

through 57, and column 10, lines 7 through 53), wherein the page is updated automatically

without further user interaction, the system comprising a link facility for inserting a link into the

document (column 11, line 33 through column 12, line 55), the link corresponding to a page

having content (column 5, line 55 through column 6, line 19, and column 11, line 33 through

column 12, line 55), a browser for retrieving the page from the network (column 4, lines 34

through 57, and column 10, lines 7 through 53), and a production facility for translating the page

into an image file suitable for insertion within the document (column 10, lines 54 through

column 11, line 55, and column 18, line 62 through column 19, line 37).

Regarding *claim 21*, Robertson discloses the system discussed above in claim 20, and

further teaches that the link facility comprises means for inserting a uniform resource locator

(URL) into the document (column 4, lines 34 through 57, column 10, lines 7 through 53, and

column 20, line 49 through column 21, line 61), wherein the URL corresponds to the page in the

network (column 20, line 49 through column 21, line 61).

Regarding *claim 22*, Robertson discloses the system discussed above in claim 20, and

further teaches that the page includes a web page, and the browser includes a web browser

(column 8, line 53 through column 10, line 31), further comprising means for inserting the link

into the document to dynamically and automatically retrieve content associated with the web

page (column 10, lines 54 through column 11, line 55, and column 18, line 62 through column

19, line 3).

Regarding *claim 23*, Robertson discloses a computer-readable medium holding

computer-executable instructions (column 7, line 19 through column 8, line 15) for importing a

page from a network and converting the page into an image file suitable for subsequent assembly

into a document generated by a document creation algorithm (see Fig. 2, column 4, lines 34

through 57, and column 10, lines 7 through 53), comprising translating the page into a page

description language (PDL) file representative of the page (column 10, lines 54 through column

11, line 55, and column 18, line 62 through column 19, line 3), and translating the PDL file into

an image file representative of the page and suitable for assembly into the document generated

by the document creation algorithm (column 18, line 62 through column 19, line 37).

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

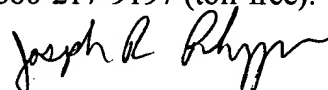Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The

examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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Joseph R. Pokrzywa
Examiner
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